UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>15 May 2008</u>.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>7 and 9-15</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>7, 9-15</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____ .
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____ .
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____ .

DETAILED ACTION

a. This action is taken to response to amendments and remarks filed on 5/15/2008.

b. Rejections and/or objections not reiterated from previous office actions are hereby
   withdrawn.

c. Claims 7, 12 and 14 have been amended. Claims 20-22 and 24-26 have been
   cancelled. Claims 7 and 9-15 are pending in the application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine
grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection
is appropriate where the conflicting claims are not identical, but at least one examined
application claim is not patentably distinct from the reference claim(s) because the examined
application claim is either anticipated by, or would have been obvious over, the reference
claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re
Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225
USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re
Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may
be used to overcome an actual or provisional rejection based on a nonstatutory double patenting
ground provided the conflicting application or patent either is shown to be commonly owned
with this application, or claims an invention made as a result of activities undertaken within the
scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal
disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR
3.73(b).

Claim 7 is provisionally rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claim 15 of copending Application No. **11/325,371**.

The following table shows the claim in Instant Application that are rejected by

corresponding claim(s) in **11/325,371**.

Instant Application	Application 11/325,371
7. A method for exchanging information between entities on a network comprising:	12. A method for deploying an annotation management system on a network comprising:
installing an annotation management system on the network;	installing the annotation management system on the network;
identifying a plurality of annotatable heterogeneous data objects, each manipulated by a corresponding one of a plurality of applications on the network. wherein each of the plurality of applications specifies an indexing mechanism for indexing data objects associated with a respective application, and wherein the indexing mechanism for each of the plurality of applications is different from one another; and	identifying an annotatable data item manipulated by at least one application on the network;
providing a set of one or more configuration tools configured to: allow a user to define an annotation structure containing one or more annotation fields for annotations created for a respective application, and wherein one or more of the annotation fields are used to store metadata included in a given annotation and wherein one or more of the annotation fields store metadata used to index an annotation according to the indexing mechanism associated with the respective application;	defining at least one annotation structure comprising one or more annotation fields; and assigning the at least one annotation structure to the data item.
associate the annotation structure with at least one of the plurality of applications; allow a user to define roles configured to determine the type of information captured or viewed in an annotation created for a given data object of a given application; and associate annotation structures defined by the user with combinations of roles and annotatable data objects.	15. The method of claim 12, further comprising: selecting a context for an annotation author; and wherein assigning the annotation structure to the data item further comprises associating the annotations structure with the selected role.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are substantially similar in scope and they use the same limitations.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Specification

Specification is objected to because of the following informalities: Page 1, [0001] is objected to because it contains attorney's docket number of a co-pending application. Correction is required.   See MPEP 608.01.

Claim Objections

Claim 7 is objected to because of the following informalities:

Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical

expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented),

(New), and (Not entered).

Claim 7 should be rewritten the entire claim with all changes (e.g., additions and

deletions), for example, the deleted matter, "wherein the configuration tools further" must be

shown by strike-through.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 7, and 9-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Bays et al.

(US Patent 6,519,603, hereinafter Bays).

As to claim 7, Bays discloses a method for exchanging information between entities on a

network (Figs. 1, 2) comprising:

installing an annotation management system on the network (Figs. 1,1A, col. 6, line 20 to

col. 7, line 8);

identifying a plurality of annotatable heterogeneous data objects (type of annotatable <u>data</u>

<u>item</u> is identified, col. 3, lines 41-47), each manipulated by a corresponding one of a plurality of

applications on the network (an annotatable data item, i.e. the subsection of database material that can be annotated, and database material may be text, graphics, spreadsheets, relational tables or any other material, i.e. heterogeneous data objects, Figs. 4-5, col. 2, lines 13-21, col. 5, lines 31-33) wherein each of the plurality of applications specifies an indexing mechanism for indexing data objects associated with a respective application (an annotatable data item can be a table, a view, a row, a cell, a column or any entity referenced by an index, e.g., by an object identifier, col. 8, lines 3-8, 20-26), and wherein the indexing mechanism for each of the plurality of applications is different from one another (the type of annotatable data item is identified and the allowed structures for this type are registered, col. 3, lines 42-47, col. 5, lines 26-33); and

providing a set of one or more configuration tools configured to:

allow a user to define an annotation structure containing one or more annotation fields for annotations created for a respective application (Figs. 3A-3D, col. 2, lines 38-46, col. 7, lines 43-50, col. 9, lines 7-49), and wherein one or more of the annotation fields are used to store metadata included in a given annotation (annotation content, Fig. 4, col. 3, lines 48-58, col. 8, lines 53-60, col. 11, lines 7-15) and wherein one or more of the annotation fields store metadata used to index an annotation according to the indexing mechanism associated with the respective application (the annotation is associated with the annotatable data item at the time of entry by including pointer information to the annotatable data item with the annotation, col. 2, lines 29-37, col. 3, lines 48-58);

associate the annotation structure with at least one of the plurality of applications (Figs. 3A-3D, col. 3, lines 42-47, col. 5, lines 26-30, col. 9, lines 43-49);

allow a user to define roles configured to determine the type of information captured or
viewed in an annotation created for a given data object of a given application (col. 9, lines 11-30,
lines 42-49); and

associate annotation structures defined by the user with combinations of roles and
annotatable data objects (formats of the annotations depend on the discipline or context [role] of
the persons or applications writing, reading, or entering the annotations, col. 5, lines 25-31, col.
7, lines 37-42, col. 8, lines 26-35, col. 9, lines 43-45).

As to claim 9, Bays discloses the method of claim 7 wherein the configuration tools
provide one or more graphical user interface screens for associating one or more roles with a user
(col. 3, lines 10-14, col. 7, lines 9-14, col. 8, lines 26-35, col. 9, lines 47-49).

As to claim 10, Bays discloses the method of claim 7 wherein the configuration tools
provide one or more graphical user interface screens for associating one or more users with a role
(col. 3, lines 10-14, col. 7, lines 9-14, col. 8, lines 26-35, col. 9, lines 47-49).

As to claim 11, Bays discloses the method of claim 7, wherein the configuration tools
allow a user to specify one or more filters specifying how annotation fields contained in an
annotation structure can be manipulated based on user roles (Figs. 3A-3D, col. 9, lines 43-49,
col. 11, lines 25-33).

As to claim 12, Bays discloses the method of claim 7, wherein the configuration tools: allow a user to specify one or more annotation field groups (col. 9, lines 11-30); and allow annotation field groups to be added to annotation structures (col. 9, lines 35-41).

As to claim 13, Bays discloses the method of claim 7, wherein the configuration tools allow a user to associate one or more transforms with an annotation structure, the transforms for use in converting the annotation structure into a graphical user interface (Fig. 2, col. 3, lines 20-33).

As to claim 14, Bays discloses the method of claim 7, wherein the configuration tools allow a user to associate an annotation structure with annotatable data objects associated with more than one heterogeneous data source (col. 2, lines 10-29, col. 5, lines 31-49, col. 9, lines 42-49).

As to claim 15, Bays discloses the method of claim 7, wherein the configuration tools allows annotatable sub-objects of data objects to be associated with annotation structures (col. 2, lines 13-29)

Response to Remarks

Applicant's arguments based on newly amended features with respect to claim7 have been fully and carefully considered but are moot in view of the new ground(s) of rejection. Refer to the corresponding sections of the claim analysis for details.

Conclusion

Applicant's amendment necessitated the new grounds of rejection presented in this Office

Action. Accordingly, **THIS ACTION IS MADE FINAL.** Applicant is reminded of the

extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Shew-Fen Lin whose telephone number is 571-272-2672. The

examiner can normally be reached on 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Shew-Fen Lin /S. L./
Examiner, Art Unit 2166
August 12, 2008

/Hosain T Alam/

Supervisory Patent Examiner, Art Unit 2166